

In the Office Action, claims 11-19 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 11 of co-pending Application No. 10/729,634. In addition, claims 11-19 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of co-pending Application No. 10/743,192. Further still, claims 11-19 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-21 of co-pending Application No. 10/729,768. In response thereto, the Applicant will file a suitable terminal disclaimer upon indication that claims 11-19 are otherwise allowable.

In the Office Action, claims 11-19 were rejected under 35 U.S.C. § 102 (b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 (a) as obvious over U.S. Patent No. 4,921,478 to Solano et al. (the '478 patent). The Office Action asserted that the '478 patent discloses a shaft having a rigid portion and a flexible portion; and an inflatable bladder which expands eccentrically when inflated. In addition, the Office Action stated that the device disclosed in the '478 patent is a retractor because it moves tissue and it would have been obvious to use a cannula with the device disclosed in the '478 patent. Applicant respectfully traverses the rejections and characterizations of the cited prior art for at least the following reasons.

The '478 patent relates to a balloon angioplasty device having two shafts 22, 24 and a symmetrical inflatable balloon 16. According to the '478 patent, the inflatable balloon 16 is attached to the distal end of shaft 24. As shown below in Figure 5A, the inflatable balloon is symmetrically mounted about the distal end of the shaft 24. Further still, when the balloon 16 is inflated, it forms a generally spherical object that is symmetrical about the distal end of the shaft 24.

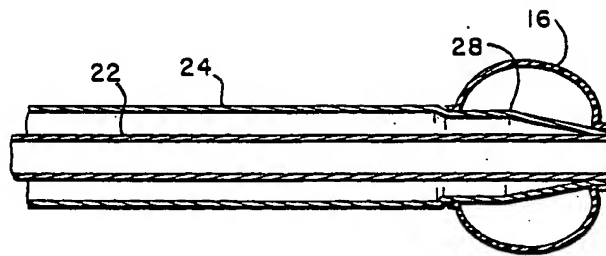


Fig. 5A

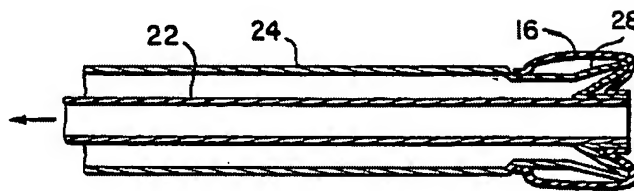


Fig. 5C

Claims 11 and 18 recite a device including, *inter alia*, “an inflatable bladder which is eccentric or eccentrically mounted on the shaft.” As shown and discussed hereinabove, the ‘478 patent discloses a *symmetrical* inflatable balloon that is *symmetrically* mounted about the distal end of a shaft and fails to disclose or suggest that the inflatable balloon is “eccentric or eccentrically mounted on the shaft” as recited in claims 11 and 18. Additionally, the ‘478 patent is directed to angioplasty devices which are used in arteries which have a generally uniform cylindrical shape and which have a balloon that is expanded to press plaque outwardly toward the artery wall. The ‘478 patent, in fact, teaches away from the device of claims 11 and 18 because with an angioplasty application in an artery having a uniform cylindrical shape, no reason exists for a bladder which is eccentric or eccentrically mounted on the shaft. Because the ‘478 patent fails to disclose or suggest this feature, claims 11 and 18 are allowable for at least this reason. Additionally, because claims 12-17 depend from independent claim 11 and claim 19

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depends from independent claim 18, the rejection of these claims should also be withdrawn at least by virtue of their dependence from allowable claims 11 and 18.


Additionally, the Office Action makes numerous unsupported assertions about what would have been obvious and what was “well known” in an attempt to remedy other deficiencies of the ‘478 patent. For example, the Office Action asserts that “it would have been obvious that the Solano et al. device is a retractor since it moves tissue,” that “it is old and well known in this art to use a cannula when inserting a catheter into the body,” and that “it is well known in the art to separately control inflatable bladders.” The Examiner has provided no support in the prior art for these assertions and it is axiomatic that “[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is ‘basic knowledge’ or ‘common sense.’” *In re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *see also* M.P.E.P. § 2144.03. To the extent the Examiner is attempting to rely on personal knowledge of the content of the knowledge generally available to one of ordinary skill in the art, Applicant submits that the Examiner has improperly taken Official Notice of the asserted subject matter. *See* M.P.E.P. § 2144.03.

In view of the foregoing, it is respectfully submitted that all claims presently pending in the application, namely claims 11-19, are in condition for allowance. Should the Examiner believe that a telephone or personal interview may facilitate resolution of any remaining matters,

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the Examiner is respectfully requested to contact Applicant's undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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